

Appl. No. 10/010,391
Atty. Docket No. 8384R
Amdt. dated June 30, 2004
Reply to Office Action of March 30, 2004
Customer No. 27752

REMARKS

Applicants would like to thank the Examiner for the telephonic interview conducted on June 29, 2004. Applicants respectfully assert that the arguments and amendments made herein are in accordance with said interview.

Claims 1, 2, 5-8, 11, 13-16, and 18, are pending in the present application. No additional claim fee is believed to be due.

Claims 1, 11, and 15 have been amended to more specifically characterize the claimed invention. Support for these amendments can be found in the specification as exemplified by page 8, lines 28-30, page 9, lines 1-5, page 21, lines 1-8. Claim 2 has been amended to correct an antecedent basis issue. Support for this amendment can be found in the specification as exemplified by page 8, lines 28-30.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC 103(a) Over Richards et. al in view of Hamilton et. al

Claims 1, 2, 5-8, 11, 13-16, and 18 have been rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 4,869,049 issued to Richards et. al in view of U.S. Patent No. 5,662,758 issued to Hamilton et. al.

In accordance with the subject telephonic interview, Applicants have herein amended independent claims 1, 11, and 15, and thus Applicants respectfully assert that the present rejection is overcome. Since claims 2, 5-8, 13, 14, 16, and 18, depend from claims 1, 11, and 15, respectively, the same rejection is similarly overcome.

During the interview, the examiner stated that the cited prior art taught all of the claim limitations of the claimed invention, particularly of claim 1 which was referenced during the interview. In addition, the examiner stated that the functional language of claim 1, while entitled to some weight, did not recite the structural elements to distinguish over the cited prior art. Last, the examiner stated that another reference was found during the examination of application serial no. 09/745,702 which was pertinent to the examination of the subject application.

In response, and as previously iterated during the interview, the cited references do not teach all of the claim limitations of the amended claims 1, 11, and 15. Below is shown a listing of claim limitations which are not taught by the Richards et. al reference.

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1.) Tying a knot: The Richards et. al reference teaches that a new formed edge is created via a knot 24 tied in the top of the flexible tubing. (See col. 3, lines 10-15). In contrast, the present invention teaches a slot which compressively gathers the tubular sheet such that the compressive gathering of the tubular sheet "causes the tubular sheet to be bonded to itself along its gathered portions in order to" form a new gathered leading edge, as recited, in part, in amended claims 1, 11, and 15.

2.) Closing / Sealing: The Richards et. al reference teaches that a package is closed by "twisting the flexible tubing 2 above the object as at 30 (Fig. 1)." (col. 3, lines 25-30). Moreover, the Richards et. al reference refers to the twisted portions of flexible tubing as "seals". (col. 3, lines 54-55). In contrast, the present invention teaches the slot which compressively gathers "the tubular sheet as the tubular sheet is inserted and moved through said slot, whereby the compressive gathering of said tubular sheet causes said adhesive to bond said tubular sheet to itself along its gathered portions in order to close and seal" as recited, in part, in amended claims 1, 11, and 15.

3.) Separating: The Richards et. al reference teaches "a series of connected closed packages 35" which can be formed "until the pleated tubing 2 is exhausted." (col. 3, lines 43-45). In contrast, the present invention teaches the slot which is "further adapted for separating the packaged article from a trailing portion of said tubular sheet... such that a series of packaged articles may be formed and disposed of in a successive and independent manner" as recited, in part, in amended claim 11.

With regard to the functional limitations, it has been held that a functional limitation in a claim "must be evaluated and considered... for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." (MPEP §2173.05(g)). Claims containing language such as "members adapted to be positioned" provide structural attributes to a claimed assembly. (See MPEP § 2173.05(g) citing *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)). Applicants assert that the above mentioned limitation of claims 1, 11, and 15 do in fact add structural limitations to the claims in that the slot is "adapted for compressively gathering said tubular sheet as the tubular sheet is inserted and moved through said slot." (See claims 1, 11, and 15)(emphasis added). Because the apparatus is adapted for compressively gathering a tubular sheet as the tubular sheet is inserted into the slot, there are structural attributes provided to the apparatus that one skilled in the art would recognize.

With regard to examination of application serial no. 09/745,702, the newly cited reference was U.S. Patent No. 3,111,796, issued to W.E. Meissner. Applicants assert that even

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with the addition of the newly cited reference, a *prima facie* case of obviousness is still not established.

In order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* Fourth, if a proposed modification to a prior art invention changes the principle operation of the prior art invention, then the cited reference does not support a *prima facie* case of obviousness. MPEP §2143.01 *citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Applicants assert that no *prima facie* case of obviousness will be established with the addition of the new reference.

First, the addition of the Meissner reference changes the principle operation of the prior art invention. The Meissner reference teaches a method for closing and sealing of containers. (col. 2, lines 1-2). A "mass or gob of film-forming material is suspended within the open end of a container, expanded into the form of a bubble, and then ruptured concomitantly as the open end of the container is collapsed" thereby providing "a continuous and uniform adhesive coating along adjacent internal surface of the container walls." (col. 2, lines 2-9).

In contrast, the Hamilton et. al reference teaches a pressure sensitive adhesive which is present on the material within valleys located between standoffs so as to protect the adhesive from accidental application. Thus, the adhesive taught in the Hamilton et. al reference is not continuously distributed. Moreover, if the adhesive of the Hamilton et. al reference were continuously distributed, then there would be no protection against accidental application.

Because the Meissner reference teaches a continuous adhesive coating, the addition of the Meissner reference to the Richards et. al and Hamilton et. al reference would deviate from the principle operation of the material taught in the Hamilton et. al reference. Because the Meissner reference would change the principle operation of the material in the Hamilton et. al reference, a *prima facie* case of obviousness cannot be sustained by the suggested combination.

Second, assuming *arguendo* that the Meissner reference did not change the principle operation of the suggested prior art invention provide the necessary motivation to combine the Richards et. al and the Hamilton et. al references, the suggested combination would still fail to establish a *prima facie* case of obviousness because the suggested combination of references fails to teach all of the claim limitations of the claimed invention. As discussed previously the

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Richards et. al reference fails to teach all of the claim limitations of amended claims 1, 11, and 15. Moreover, neither the Hamilton et. al reference nor the Meissner reference teach the limitations which the Richards et. al reference fails to teach. Therefore, the suggested combination of references does not teach all of the claim limitations of amended claims 1, 11, and 15.

Because the suggested combination of references changes the principle operation of the prior art invention and because the suggested combination of references fails to teach all of the claim limitations of amended claims 1, 11, and 15, a *prima facie* case of obviousness has not been established. Therefore, claims 1, 11, and 15 are unobvious over the cited references. Moreover, because claims 2, 5-8, 13, 14, 16, and 18 depend from amended claims 1, 11, and 15, a *prima facie* case of obviousness is equally not established for these claims. Therefore, claims 2, 5-8, 13, 14, 16, and 18, are unobvious over the cited references as well.

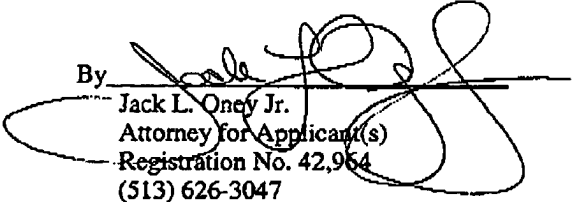
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 2, 5-8, 11, 13-16, and 18.

Respectfully submitted,
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June 30, 2004
Customer No. 27752
(Amendment 3-30-04.doc)(GHL)
Revised 10/14/2003